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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,330

08/23/2006

Louis Robert Litwin

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EXAMINER

WITZENBURG, BRUCE A

ART UNIT

PAPER NUMBER

2169

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/590,330

Applicant(s)

LITWIN ET AL.

Examiner

Bruce A. Witzenburg

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/23/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-20 are pending in this application.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed on 8/23/2006 is in compliance with the provisions of 37 CFR 1.97, and has been considered by the examiner. a copy is included with this office action

#### ***Drawings***

3. The drawings filed on 8/23/2006 are acceptable for examination purposes.

#### ***Claim Objections***

4. The following are objected to for lack of antecedent basis:
  - a. "the at least one first e-mail message" (claim 2, lines 3-4)
  - b. "the associated e-mails" (claim 4, lines 1-2; claim 5, lines 1-2)
  - c. "the associated group of emails (claim 8, line 2)
  - d. "the user's mailboxes" (claim 9, line 3)
  - e. "the discussion topic" (claim 9, line 4; claim 18, lines 5-6)
  - f. "the discussion topic heading" (claim 10, line 7; claim 12, line 2; claim 13, lines 1-2)
  - g. "the at least one e-mail" (claim 18, line 5)

The examiner would like to note that many of the above objections appear to be due to inconstant verbiage (i.e. "an associated group" - claim 1, line 5 potentially referring to "the associated group – claim 2, line 7; claim 6, line 2, claim 7, line 2, 3 and all of item b. and c. mentioned above).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-20 are directed towards software per-se and therefore do not constitute software subject matter. A system must be directed towards a physical embodiment and a software system thus must be embodied on a physical computer readable storage medium in order to be directed towards statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6, 8 and 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrawal et al. (US 6,592,627) hereafter Agrawal.

Regarding claim 1, Agrawal discloses A method for organizing e-mail messages (Abs)

comprising the steps of:

indicating at least one first e-mail message in a user mailbox; (Col 1, line 66 – Col 2, line 3)

associating the at least one first e-mail with a second e-mail by user-enablement of an association option (Col 2, lines 2-11 and Col 2, lines 38-41);

and forming an associated group in the user mailbox comprising at least two or more associated e-mails (Col 2, lines 38-41).

Regarding claim 6, Agrawal discloses providing a collapsibility and expandability feature for the associated group (Abs Note that the implementation uses folders which are inherently collapsible and expandable).

Regarding claim 8, Agrawal discloses the step of providing e-mail operations for performing on the associated group of e-mails (Col 7, lines 50-56 Note that Agrawal pertains to an e-mail inbox view which would inherently provide e-mail operations to be performed).

Regarding claim 15, Agrawal discloses an e-mail system (Col 7, lines 50-56)

comprising:

e-mail software for providing e-mail capabilities to a user (Col 7, lines 50-56);

and an associate feature for providing interactive e-mail organization capabilities to the user by organizing e-mail messages according to user input to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes (Col 1, line 66 – Col 2, line 3 or Col 2, lines 42-44).

Regarding claim 20, Agrawal discloses an auto-process feature for automatically parsing a received e-mail to search for an existing discussion thread, wherein if an existing discussion thread is found, the received e-mail is automatically associated to the discussion thread (Col 2, lines 42-44).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal.

Regarding claim 9, Agrawal discloses a method for organizing e-mail messages (Abs) comprising the steps of:

associating at least one e-mail message to the user-created discussion topic via user-enablement of an association option to form an associated e-mail-to-topic group (Col 1, line 66—Col 2, line 3)

Agrawal does not disclose creating a user-defined discussion topic heading, said discussion topic heading appearing as an entry in at least one of the user's mailboxes however it would have been obvious to one of ordinary skill in the art at the time of the invention to name the folders as created by the implementation of Agrawal by data pertinent to its contents such as discussion topics (as per common folder naming convention) in order to efficiently organize the user's inbox.

8. Claims 2-5, 10-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of Rosenschein et al. (US 6,341,306) hereafter Rosenschein.

Regarding claim 2, Agrawal discloses

selecting an associate option (Col 2, lines 22-30 and Col 7, lines 57-64);

and indicating the second e-mail (Col 2, lines 22-30 and Col 7, lines 57-64 Note it is inherent in the implementation that in order to associate the document that it must be indicated and selected in some manner in order to move the document);

wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form the associated group (Col 2, lines 8-11), however Agrawal does not disclose enabling an options list to appear

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have been obvious to one of ordinary skill in the art to provide user functionality through the option lists in order to provide user functionality.

Regarding claim 3, Agrawal as modified discloses the step of providing a show associations and a hide associations option on the options list (Col 7, lines 53-56).

Regarding claim 4, Agrawal as modified discloses showing the associated e-mails of a sent e-mail message to a recipient when the show associations option is selected (Col 7, lines 53-56 Note the logic to switch views would inherently be able to toggle views based upon selected view).

Regarding claim 5, claim 5 is rejected for substantially the same reason as claim 4 above.

Regarding claim 10, claim 10 is rejected for substantially the same reason as claim 2 above.



Regarding claim 11, claim 11 is rejected for substantially the same reason as claim 3 above.

Regarding claim 12, claim 12 is rejected for substantially the same reason as claim 4 above. Additionally note a 'normal inbox view' does not include association topics as is standard in the art at the time of the invention.

Regarding claim 13, claim 13 is rejected for substantially the same reason as claim 12 above.

Regarding claim 14, claim 14 is rejected for substantially the same reason as claim 6 above.

Regarding claim 16, Agrawal does not disclose an options list with respect to each e-mail message, said options list comprising said associate feature,

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have been obvious to one of ordinary skill in the art to provide user functionality such as the associate function of Agrawal (Col 2, lines 8-11).

Regarding claim 17, claim 17 is rejected for substantially for the same reason as claim 2 above.

Regarding claim 18, Agrawal discloses the associated e-mail-to-topic group being formed by creating a user-defined discussion topic heading (Col 1, line 66 - Col 2, line 3) While Agrawal does not disclose causing the options list to appear with respect to at least one e-mail message, selecting the associate feature from said options list, and indicating the discussion topic heading, wherein the at least one e-mail is caused to be automatically associated to the discussion topic to form the associated e-mail-to-topic group and said discussion topic heading appears as an additional field in said at least one e-mail message.

Rosenschein discloses right clicking to enable an option list which provides functionality to appear regarding a document such as email (Col 2, lines 9-18) and it would have been obvious to one of ordinary skill in the art to provide user functionality such as the associate function of Agrawal (Col 2, lines 8-11). Additionally, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the discussion topic or related information as a field within the document to facilitate indexing and other forms of easy organization.

Regarding claim 19, claim 19 is rejected for substantially for the same reason as claim 3 above.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in further view of Kekic et al. (US 5,999,179) hereafter Kekic.

Regarding claim 7, Agrawal does not disclose providing graphical indicators showing when the associated group is expanded or collapsed, however expandable and collapsible folder icons associated with folders are well known to one of ordinary skill in the art at the time of the invention as can be demonstrated by Kekic Col 23, lines 65-67 and it would have been obvious to one of ordinary skill in the art to indicate an open or closed group to further facilitate ease of use.

### ***Conclusion***

1. The prior art made of reference in this case is as follows:
  - a. Agrawal et al. (US 6,592,627)
  - b. Rosenschein et al. (US 6,341,306)
  - c. Kekic et al. (US 5,999,179)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce A. Witzenburg whose telephone number is 571-270-1908. The examiner can normally be reached on M-F 9:00 - 6:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Mohammed can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BW

  
MOHAMMAD ALI  
SUPERVISORY PATENT EXAMINER